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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,042	12/22/2000	William B. Whitten II	2000-0556	9058

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EXAMINER

MANIWANG, JOSEPH R

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,042

Applicant(s)

WHITTEN, WILLIAM B.

Examiner

Joseph R Maniwang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The corrected drawings were received on 08/1/204. These drawings are accepted.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liffick (U.S. Pat. No. 6,421,439), hereinafter referred to as Liffick, and further in view of Aravamudan (U.S. Pat. No. 6,301,609), hereinafter referred to as Aravamudan, or alternatively, Aravamudan in further view of Liffick.

4. Liffick disclosed a communication system providing user control of a contact list used for filtering incoming calls. Liffick disclosed a contact list that could be segmented into a series of sublists (see column 7, line 57 through column 8, line 5). The recipient user had control over the segmented contact lists, where each list could be categorized and controlled by an accessibility level (see column 9, lines 7-55). A segmented list could be given a status level of accessibility, including blocked or non-blocked status (see column 8, lines 35-48). Liffick also disclosed associating a priority for granting

accessibility to a list (see column 9, lines 45-55). This list was accessible to the user in real-time over the Internet for modification (see column 10, lines 43-49). Liffick disclosed such a contact list to be useful in monitoring an online status of another computer (see column 7, line 57 through column 8, line 5). Furthermore Liffick disclosed the preference of some of these users to "chat" with other subscribers using an associated alias (see column 9, line 56 through column 10, line 13).

5. While disclosing the use of a contact list for monitoring the availability of another user on the Internet and the preference of such users to chat using an associated alias, Liffick did not specifically disclose the invention in an instant messaging context.

6. Aravamudan disclosed a communication system utilizing an instant messaging system for providing advanced features and capabilities in existing communication systems. The system of Aravamudan was similar to that of Liffick in that incoming phone calls could be filtered according to rules specified by the recipient user. The rules were defined by a user's contact list, and by priority assigned to contacts on the list (see column 5, line 52 through column 6, line 31). The invention of Aravamudan achieved such control by making use of an industry standard instant message server and combining it with a telephone network (see column 5, lines 15-51).

7. While Aravamudan disclosed the use of an instant messaging contact list for controlling communications to a user, Aravamudan did not specifically disclose segmenting the contact list and specifying an accessibility level of the segmented list.

8. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Liffick and Aravamudan to provide user control of

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a contact list, wherein the contact list could be segmented for the purpose of specifying an accessibility level of the segmented list in an instant messaging system. The combination of teachings would also have provided a way for designating to a segmented list a blocking/non-blocking status, a priority, and message acceptability from the senders in the segmented list. Liffick disclosed the desire for users on a network to "chat" using an alias (see column 9, line 56 through column 10, line 13), leading one of ordinary skill to consider ways of incorporating a "chat" (i.e., instant messaging) system in the invention of Liffick. Aravamudan disclosed a system similar to Liffick that incorporated such an instant messaging system. One of ordinary skill in the art would have been motivated to consider the teachings of Aravamudan since they were a way of joining conventional phone technologies and computer instant messaging, creating a more unified system where users could gain more features and services and thus allowing for chatting in a conventional phone system (see column 1, line 59 through column 2, line 22; column 11, lines 8-45). Alternatively, Aravamudan disclosed the use of a contact list and an instant messaging system for controlling communications between a sender and a recipient user. One of ordinary skill in the art would have been motivated to consider incorporating the control features disclosed by Liffick (such as segmenting a list and specifying the accessibility level of the segmented list as blocked/not blocked or prioritized) as this control scheme provided greater user control over incoming communications from senders (see column 2, line 57 through column 3, line 4; column 13, lines 41-52).

Response to Arguments

9. Applicant's arguments filed 08/12/04 have been fully considered but they are not persuasive.

10. Regarding claims 1 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Liffick (U.S. Pat. No. 6,421,439) in view of Aravamudan (U.S. Pat. No. 6,301,609), Applicant generally asserts that the references fail to teach or suggest an instant messaging system that includes generating a recipient user controlled contact list, segmenting the contact list, and specifying a message category membership in each segmented contact list as a technique of specifying accessibility levels to messages of selected segments of the segmented contact list. Examiner submits however that the references do teach the broad concepts claimed as recited in the above rejection. As recognized by Applicant, Liffick "provides user control of a contact list", "that could be segmented into a series of sub lists", and Aravamudan "utilizes instant messaging" (see Remarks, p. 5, section II), describing the broad concepts of a recipient user controlled contact list, segmenting the contact list, and an instant messaging system.

Furthermore, as noted above, Liffick disclosed categorizing the segmented contact list by an accessibility level, including blocked or non-blocked status (see column 8, lines 35-48; column 9, lines 7-55). Clearly then, Liffick suggests the broad concept of specifying a message category membership in each segmented contact list for specifying accessibility levels as claimed.

11. Applicant states that the references fail to teach allowing certain messages to reach the user recipient while preventing other messages from reaching a user recipient

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(e.g., an emergency vs. a non-emergency message category). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., emergency/non-emergency message categories) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Liffick, however, does in fact teach assigning a segmented list a status level of accessibility, including blocked or non-blocked status (see column 8, lines 35-48), thus reading upon the broad concept of allowing or preventing certain messages to reach the user recipient.

12. Applicant notes that Liffick teaches a method and system for user affiliation in a telephone network for managing incoming calls, concluding that Liffick is not related to the management of incoming instant messages, and thus does not teach and that there would be no need to teach generating and segmenting an instant messaging contact list for specifying a message category membership for each segmented contact list.

Examiner disagrees. Liffick discloses the use of an affiliation list, comprising a series of sublists including a forward list, reverse list, block list, and allow list. Liffick discloses that the forward list contains a list of Internet subscribers whose Internet activity a user wishes to monitor, also known as a "buddy list" (see column 7, lines 57-63). Examiner submits that this is the very definition of an instant messaging contact list as claimed. Furthermore, Liffick suggests using the affiliation list to allow Internet subscribers to "chat" with each other using an alias (see column 9, line 66 through column 10, line 2).

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Examiner submits that this is a very clear indication of and motivation for one of ordinary skill in the art to consider the use of the functionality described by Liffick in the context of an instant messaging system as claimed. Applicant further asserts that as Examiner previously stated that "Aravamudan did not specifically disclose segmenting the contact list and specifying accessibility level of the segmented list", both references thus fail to disclose this limitation. Examiner submits that this assumption is incorrect.

Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is noted that although Applicant considers Liffick unrelated to instant messaging, this in no way discredits Liffick as a primary reference as suggested by Applicant. The shortcomings of Liffick previously noted by Examiner were considered in view of Aravamudan in order to reject the claimed limitations in view of the combination of teachings provided by the references. Applicant's arguments against Liffick alone rather than Liffick in view of Aravamudan fail to consider the combination of teachings provided by the references and are thus not persuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A Cuchlinski can be reached on (571) 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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